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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/709,038	11/10/2000	ROBERT A. KOCH	36968/202435	3243

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EXAMINER
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LEZAK, ARRIENNE M

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 04/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/709,038

Applicant(s)

KOCH, ROBERT A.

Examiner

Arrienne M. Lezak

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,4,6-12,14-29 and 31-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6-12,14-29 and 31-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. ____   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____  | 6) <input type="checkbox"/> Other: ____                                     |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10 February 2006 has been entered.
2. Examiner notes that Claims 1, 3, 4, 6-12, 14-29 & 31-36 have been amended, no claims have been cancelled and Claims 37-47 have been added. Claims not explicitly addressed herein are found to be addressed within prior Office Action dated 12 August 2005 as reiterated herein below.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
4. Claim 23 & 34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the

invention. Specifically, Claims 23 & 34 recite the limitation "the processor receives a notification that the contact device is active". In light of their dependencies upon Claims 12 & 24 respectfully, Claims 23 & 34 are found to be confusing. Specifically, Examiner is unsure where within the process the processor receives this notification. A notification following communication initiation is confusing and not supported within the specification; therefore, Examiner will interpret the claim language to mean that notification is received prior to "the processor causing presentation of the recipient's presence information to the sender".

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 4 recites the claim language "the plurality of addresses" and "the contact devices". There is insufficient antecedent basis for this limitation in the claim. Proper correction is required.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 3, 4, 6-12, 14-29 & 31-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent US 6,564,261 B1 to Gudjonssoin view of US Patent US 6,807,423 B1 to Armstrong.

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9. Regarding Claims 1, 12, 18, 22-24, 29, 34, 35, 37, 42 & 43, Gudjonsson teaches a method, system and computer readable medium for presenting presence information to a sender of a communication, (Abstract; Claims 1-20; Col. 2, lines 51-67; Col. 2, lines 1-63; Col. 34, lines 26-63; Col. 36, lines 41-46; Col. 38, lines 61-67; and Col. 39, lines 1-67), comprising:

- An input for receiving presence information of a recipient indicating the recipient's presence at a plurality of contact devices, (Figs. 8-9 & Col. 25, lines 43-63 – Carl chooses “voice chat”);
- Processing and providing the communication presence information, (notification that the contact device is active – per pending Claims 23 & 34), for display to the sender, (per pending Claims 18 & 29), (Figs. 8-9 & Col. 25, lines 43-63 – invite sent to Anne wherein the routing service notes that she is off-line but receiving calls at her active GSM phone and a reply is sent to Carl including GSM number);
- receiving a selection from the sender, (based on the presence information – per pending Claims 22, 35 & 42), to initiate communication with one of the chosen member's available contact devices, (Col. 25, lines 43-63 – Carl calls the number provided to him based on Anne's presence information);
- wherein the user is able to determine which contact device is available by viewing the profile information, (graphical indicator), on the members of the communications circle and can initiate contact with any member

having an available contact device (via selection of that contact device), (Figs. 8 & 9; Col. 3, lines 1-13; Col. 4, lines 31-38; Col. 8, lines 47-67; Col. 9, lines 1-22; Col. 11, lines 44-67; Col. 12; Col. 13, lines 1-18; and Cols. 23-26).

10. Examiner notes that Gudjonsson clearly teaches receipt of recipient presence information at an individual device, wherein it would have been obvious for a recipient to be available at more than one contact device. That noted, Applicant argues that Gudjonsson “only determines whether a user is logged in without presenting a distinction of the user’s online status at a plurality of contact devices”, and Examiner finds that an indication of available contact device(s) was well-known at the time of invention by Applicant. Additionally, Examiner provides the Armstrong reference which reference further illustrates the notion of providing “watched party” information comprising “the type of communication network(s) the watched party is available on”, (Armstrong – Col. 3, lines 47-52 & Col. 4, lines 58-64). It would have been obvious to one of ordinary skill in the art at the time of invention by Applicant to include the network/device monitoring information as part of the Gudjonsson communication network, motivation for which being an easy way to advertise availability of other (network) users to communicate, (Gudjonsson – Col. 2, lines 32-33). Thus, Claims 1, 12, 18, 22-24, 29, 34, 35, 37, 42 & 43 are found to be unpatentable over the combined teachings of Gudjonsson and Armstrong.

11. Regarding Claim 3, Gudjonsson and Armstrong are relied upon for those teachings noted herein. Gudjonsson further teaches receiving authorization to present

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the second user's presence information to the first user, (Col. 11, lines 20-64). Thus, Claim 3 is found to be unpatentable over the combined teachings of Gudjonsson and Armstrong.

12. Regarding Claim 4, Gudjonsson and Armstrong are relied upon for those teachings noted herein. Gudjonsson further teaches wherein a plurality of addresses represents at least one of different types of communications and different types of contact devices, (Col. 11, lines 44-64). Thus, Claim 4 is found to be unpatentable over the combined teachings of Gudjonsson and Armstrong.

13. Regarding Claims 6 & 7, Gudjonsson and Armstrong are relied upon for those teachings noted herein. Gudjonsson further teaches wherein the second user's presence information is presented in an electronic interface, (per pending Claim 6), (Figs. 8-9), the contact device is a wireless device, the user is connected via the communications server through a wireless network, (Col. 2, lines 51-67; Col. 3, lines 1-62), and wherein the interface is for display on a personal computer, a wireless device, a pager or a wireless telephone, (per pending Claim 7), (Abstract; Col. 3, lines 51-59; Col. 25, lines 6-9; and Col. 33, lines 6-48). Thus, Claims 6 & 7 are found to be unpatentable over the combined teachings of Gudjonsson and Armstrong.

14. Regarding Claim 8, Gudjonsson and Armstrong are relied upon for those teachings noted herein. Gudjonsson further teaches wherein the step of retrieving the presence information is at least in part determined based on a time or a day of week preference from a profile of the second user, (Col. 23, lines 12-32). Thus, Claim 8 is found to be unpatentable over the combined teachings of Gudjonsson and Armstrong.

15. Regarding Claims 9, 19 & 31, Gudjonsson and Armstrong are relied upon for those teachings noted herein. Gudjonsson further teaches presenting a graphical indicator that obviously indicates the second user's presence at the plurality of contact devices, (Gudjonsson - Figs. 8-9), when an optional routing service is not chosen as a basic service, thus creating a need for the well-known option direct communication choices via a selection enumerating specific available communication option(s), (Armstrong – Col. 47-52). Thus, Claims 9, 19 & 31 are found to be unpatentable over the combined teachings of Gudjonsson and Armstrong.

16. Regarding Claims 10, 20 & 32, Gudjonsson and Armstrong are relied upon for those teachings noted herein. Gudjonsson further teaches wherein the step of presenting the presence information comprises causing display of the presence information to the first user, (per pending Claim 10), via an icon used to initiate communication, (per pending Claims 20 & 32), (Figs. 8-9; Col. 11, lines 44-64; & Col. 13, lines 5-18). Thus, Claims 10, 20 & 32 are found to be unpatentable over the combined teachings of Gudjonsson and Armstrong.

17. Regarding Claims 11, 21 & 33, Gudjonsson and Armstrong are relied upon for those teachings noted herein. Gudjonsson further teaches wherein the step of retrieving the presence information comprises at least one of querying the contact device, or querying the network provider associated with the contact device, (Col. 2, lines 51-67; Col. 3, lines 1-62; Col. 8, lines 47-67; and Col. 9, lines 1-61), (Examiner again notes that the user ID is obviously and clearly the means by which users within



the Gudjonsson system are identified). Thus, Claims 11, 21 & 33 are found to be unpatentable over the combined teachings of Gudjonsson and Armstrong.

18. Regarding Claims 14-17, 25-28, 38-41 & 44-47, Gudjonsson and Armstrong are relied upon for those teachings noted herein. Gudjonsson further teaches wherein the processor initiates a telephone call to a telephone number associated with the selected contact device, (per pending Claims 14, 25, 38 & 44); an Internet Telephony call from the sender to the recipient, (per pending Claims 15, 26, 39 & 45); an electronic message to an email address, (per pending Claims 16, 27, 40 & 46); or an electronic message to a text messaging address, (per pending Claims 17, 28, 41 & 47), (Col. 2, lines 51-67; Col. 3, lines 1-62). ). Thus, Claims 14-17, 25-28, 38-41 & 44-47 are found to be unpatentable over the combined teachings of Gudjonsson and Armstrong.

19. Regarding Claim 36, Gudjonsson and Armstrong are relied upon for those teachings noted herein. Gudjonsson further teaches instructions for causing display of an icon to indicate presence at least one of a phone, a personal digital assistant, a pager, a computer and an interactive television, (Figs. 8-9). Examiner again notes that Gudjonsson clearly teaches presenting a graphical indicator that obviously indicates the second user's presence at the plurality of contact devices when an optional routing service is not chosen as a basic service, thus creating a need for the well-known option direct communication choices via a selection enumerating specific available communication option(s), (Armstrong – Col. 47-52).

20. Additionally, Gudjonsson does not specifically enumerate the use of an interactive television or a personal data assistant. To apply the functionalities inherent

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to the Gudjonsson system to an interactive television device or personal data assistant, would have been obvious to one of ordinary skill in the art at the time of invention by Applicant. Specifically, as noted above, Gudjonsson indicates the use of client devices, including but not limited to PCs and mobile phones, wherein the Internet and other communication sessions include, but are not limited to text chat, voice chat, web conference or pages, (Col. 3, lines 51-63). As a personal data assistant is a form of portable personal computer and an interactive television is an Internet/web-type communication device, Examiner finds that to incorporate the Gudjonsson system upon the a personal data assistant or an Internet-capable interactive television would have been obvious in light of that which Gudjonsson discloses. Thus, Claim 36 is found to be unpatentable over the combined teachings of Gudjonsson and Armstrong.

### ***Response to Arguments***

21. Applicant's arguments filed 10 February 2006, have been fully considered but they are not persuasive. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how reconsideration avoids such references or objections.

22. Examiner notes Applicant's concern that the Gudjonsson art teaches away from Applicant's claimed invention, in that Gudjonsson's routing service "removes the need for the user to have specific knowledge of available receiver devices", (Applicant

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Amendment dated 10 February 2006 – p.18), and Examiner respectfully disagrees.

Specifically, Gudjonsson teaches the use of “services”, which are software entities with arbitrary functions, (Gudjonsson – Col.2, lines 63-65), wherein basic services which

may be provided within each cluster include, for example: dynamic user properties,

(presence info.); contact list and contact notification; and routing service, (Gudjonsson –

Col. 3, lines 1-13). In other words, Examiner finds that the use of a routing service in

Gudjonsson is completely optional, and further, that direct communication is entirely

possible, albeit impractical in terms of catering to the needs of the end users within the system.

23. Regarding Applicant’s concern that the Gudjonsson art does not “receive a selection from the sender that selects a contact device to which the communication is addressed”, “initiating the communication from the sender to an address of the selected contact device”, arguing that “the routing service completely determines where a communication is delivered”, again, Examiner respectfully disagrees. Specifically, Examiner notes that within Gudjonsson, the sender is free to choose any type of communication (invitation/contact method) means they desire, wherein individual user specified logic dictates how the communication will be received, (Gudjonsson – Col. 13, lines 5-30), (Applicant Amendment dated 10 February 2006 – p.17). Moreover, In response to applicant’s argument that the references fail to show certain features of applicant’s invention, it is noted that the features upon which applicant relies (i.e., “the sending of invitations directly between users”) are not recited in the rejected claim(s).

Although the claims are interpreted in light of the specification, limitations from the

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specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Though as noted herein, as the routing service is an optional service, absent the same, it would have been obvious for communication between users to be direct.

24. Moreover, Examiner notes that the Claims as amended are still anticipated by the prior art as the user is able to select which device or means by which other users will be contacted via an "invite", wherein the types of "invites" available are graphically indicated, (Figs. 8 & 9), wherein the "routing service" serves to send the invite after the user chooses the device, and wherein the routing service provides an alternative contact or notification means if the means chosen by the user are unavailable at the time. Again, Examiner notes that the routing service does not choose the method by which the user sends the message, but rather allows for a means by which messages are received in the event that the user-chosen device is unavailable. In other words, the routing service serves to forward the messages as set up by the receiver as needed, (Col. 25, lines 6-67 & Col. 26, lines 1-36), which removes the need for the user to have specific knowledge of available receiver devices. Therefore, Examiner finds that Gudjonsson renders the claims unpatentable. Additionally, Examiner notes that Gudjonsson also provides for a first selection, (presence verification), and second selection, (communication initiation), in addition to the utilization of unique identities and authentication means for controlling user access and communication as noted herein above.

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25. Thus, as Examiner has completely addressed Applicant's amendment, and finding Applicant's arguments do not show how the amended claims avoid such references or objections, Examiner hereby maintains the rejection of all claims, in their entirety.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US Patent US 6,760,754 B1 to Isaacs; and

US Patent US 6,463,471 B1 to Dreke.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arrienne M. Lezak whose telephone number is (571)-272-3916. The examiner can normally be reached on M-F 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571)-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Arrienne M. Lezak", is written over the printed name and title.

Arrienne M. Lezak  
Examiner  
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